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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,433	11/12/2003	Timothy D. Smythe JR.		7148

7590

07/18/2005

Clifford Kraft
320 Robin Hill Dr.
Naperville, IL 60540

EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/706,433	Applicant(s) SMYTHE, TIMOTHY D.	
	Examiner Yvonne M. Horton	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-12 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-23 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Regarding claim 9 is, the phrase "wave-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "wave-like"), thereby rendering the scope of the claim(s) unascertainable.

Regarding claim 16 is, the phrase "can be" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9,10,11 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1,5,6 of copending Application No. 10/200,478 in view of US Patent #4,313,991 to LAMB. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

A rigid member having finishing paper layer on an external surface to receive a paint or texture. 10/200,478 discloses the basic drywall product except for the use of patterns formed on an interior. LAMB discloses that it would have been obvious to add patterns on an interior surface of the rigid member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the drywall device of a 10/200,478 with the protrusions of LAMB in order to improve adhesion or securing of the drywall device to the wall.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 stands rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #4,863,774 to TUCKER. TUCKER inherently discloses a method of making a drywall product (14,40,60,80) including the steps of extruding an elongate semi-rigid support member (44,64) to form a pair of flanges (not labeled) with a grooved hinge

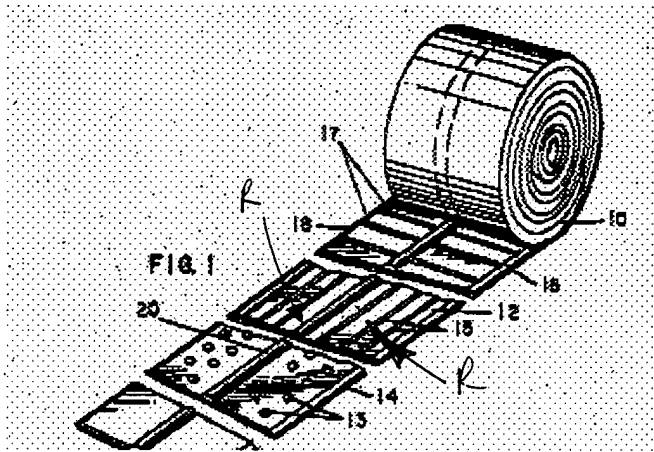
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(see figure 5) running along a center-line thereof; wherein the support members (14,40,60,80) includes a fibrous outer layer (42,62,82); and producing a plurality of furrows (20) and protrusions/ridges (22) thereby forming an "up (ridge)/down (furrow)" or wave, corrugated, column 5, line 12, pattern on an inner surface of the support members (44,64) to receive drywall mud (column 2, lines 57-60).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 9-12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,090,087 to MILLER in view US Patent #4,313,991 to LAMB. MILLER discloses a rigid member (10) having a finishing paper layer (13) that can be painted or spackled, column 3, lines 44-48. MILLER discloses the basic claimed drywall device except for the inclusion of a pattern of protrusions and except for the rigid member being plastic and tapered. LAMB teaches that it is known in the art to form a drywall member (12) out of plastic, column 3, line 30; tapered edges (16,18), column 2, lines 43-44; and a pattern of grooves (15,17) thereby forming alternating raised protrusions (R), see figure below, having a "wave-like" configuration. It would have been obvious to



one having ordinary skill in the art at the time the invention was made to form the rigid member of MILLER out of plastic and to provide the rigid member of MILLER with the protrusions and tapered edges of LAMB in order to form a drywall member that is not corrosive, and that enables the member to be firmly secured flush with the wall surface. Regarding claim 10, MILLER, as modified by LAMB teaches a rigid plastic member. However, LAMB does not specify the type of plastic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material on the basis of its suitability for the use intended is an obvious matter of design choice. For instance, the selection of material used to form the rigid member depends upon the strength needed in the member and environment of the wall in which the device will be attached. Perhaps one type of plastic might adhere to a certain wall surface better than another type of plastic. In reference to claim 11, MILLER, as modified by LAMB, teaches the use of a kraft paper. However, there is no teaching of "cup stock" paper. Again, the selection of a known material on the basis of its suitability for the use intended is an obvious matter of design choice. Regarding

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claim 12, the paper finishing layer (13) of MILLER extends beyond the edges (16,18) of the rigid member (12), see the figures.

Claims 2-3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,863,774 to TUCKER. TUCKER discloses the basic claimed method except for tapering the flanges. Regarding claim 2, tapering is old and very well known in the art. Although TUCKER does not taper his flanges, it would have been obvious to one having ordinary skill in the art at the time the invention was made to taper the flanges of TUCKER in order to ensure that the drywall device fits flush against the wall surface thereby making it easier to provide a smooth exterior wall finish. In reference to claim 3, the finishing layer (50) extends beyond the support member (42).

Claims 4-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,863,774 to TUCKER. TUCKER discloses the basic claimed method except for explicitly detailing that the support member is a polystyrene plastic and except for explicitly detailing that the finishing paper is "cup stock" paper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material on the basis of its suitability for the use intended is an obvious matter of design choice. For instance, the selection of material used to form the rigid member depends upon the strength needed in the member and environment of the wall in which the device will be attached. Perhaps one type of plastic might adhere to a certain wall surface better than another type of plastic. In reference to claim 11, MILLER, as modified by LAMB, teaches the use of a kraft paper. However, there is no

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teaching of "cup stock" paper. Again, the selection of a known material on the basis of its suitability for the use intended is an obvious matter of design choice.

Allowable Subject Matter

Claims 16-20 remain as being allowed.

Claims 21-23 are allowed.

Response to Arguments

Applicant's arguments filed 5/16/05 have been fully considered but they are not persuasive. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

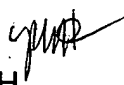
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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


YMH
Art Unit 3635
07/14/05


Jeannette S. Chym
Primary Examiner